

REMARKS

Applicants submit this Amendment in response to the final Office Action mailed December 28, 2008.

By this Amendment, Applicants amend claim 14 and add new claims 88 and 89. The originally filed specification, drawings, and claims fully support the subject matter of amended claim 14 and new claims 88 and 89. Claims 1-12, 14-25, 27, and 78-89 remain pending in this application. Claims 1 and 14 are the sole independent claims.

As an initial matter, Applicants would like to thank Examiner Lloyd and Examiner Hindenburg for the courtesies extended to the Applicants representative during the telephonic interview of February 21, 2008. During the interview, the Applicants' representative and Examiner Lloyd discussed proposed amendments to claims 1 and 14 and the Paternuosto reference. No agreement was reached.

Rejection of Claims 14-20, 22-25, and 83-85 under 35 U.S.C. § 102(b)

On page 2 of the final Office Action, claims 14-20, 22-25, and 83-85 were rejected under 35 U.S.C § 102(b) as being anticipated by International Publication Number WO 01/30242 to Paternuosto ("Paternuosto"). Applicants respectfully traverse the rejection.

Paternuosto does not disclose or suggest the claimed invention. For example, amended independent claim 14 recites a device for storing a plurality of tissue samples comprising, among other aspects "wherein a bottom portion of the elongate container closer to the open bottom than to the open top has an hourglass shape configured to prevent tissue samples smaller than the open bottom from exiting the container via the

open bottom.” Paternuosto does not disclose at least this aspect of amended claim 14 either alone or in combination with other aspects of amended claim 14.

Pages 2 and 3 of the final Office Action assert that the portion of container element 22 around hole 18 corresponds to the claimed “open top,” opening 24 in the base wall of container element 22 corresponds to the claimed “open bottom,” and the walls of container element 22 immediately above and below hole 18 (i.e., the restricted neck) form the claimed “hourglass shape.” Even assuming *arguendo* that is correct, Paternuosto fails to disclose, teach, or otherwise suggest that the restricted neck is “closer to the open bottom than the open top.” Instead, Paternuosto explicitly discloses on page 5, paragraph 4 that “half-shell 10b ... has, in its base wall 14, the hole 18 in which the end of the beaker-shaped container element 22 is fixed by means of an annular layer of adhesive 30, this end being open and having a restricted neck.” This is further illustrated in Fig. 7, where Applicants note the broken lines indicate that container element 22 is longer than shown. Therefore, Paternuosto discloses that the restricted neck is closer to the portion of container element 22 around hole 18 than opening 24 in the base of container element 22, opposite to that claimed.

Even if the restricted neck was closer to the opening 24 in the base of container element 22 than the portion of container element 22 around hole 18 (which it is not), the shape of that restricted neck of container element 22 would not “prevent tissue samples smaller than the open bottom from exiting the container via the open bottom.” Instead, the restricted neck of container element 22, as shown in Fig. 7, is larger than opening 24. The restricted neck, therefore, permits the passage of samples smaller than opening 24 which then can exit container element 22 via opening 24.

Accordingly, claim 14 is allowable for at least these reasons. Claims 15-25 and 83-87 depend from claim 14 and are allowable for at least the same reasons that claim 14 is allowable.

Rejection of claims 1-7, 9-12, 27, and 78-80 under 35 U.S.C. § 103(a)

On page 6 of the final Office Action, claims 1-7, 9-12, 27, and 78-80 were rejected under 35 U.S.C § 103(a) as being unpatentable over Paternuosto. Applicants respectfully traverse the rejection.

Paternuosto does not disclose or suggest the claimed invention. For example, claim 1 recites a device for storing a plurality of tissue samples comprising, among other aspects, “a portion of the elongate container adjacent the open bottom having an hour-glass shape defining a restriction smaller than the open bottom to prevent the plurality of tissue samples from passing through the restriction and exiting the container via the open bottom.”

Page 6 of the final Office Action alleges that the walls of container element 22 immediately above and below hole 18, as shown in Fig. 7, form the claimed hourglass shape, and that opening 24 at the bottom of container element 22 corresponds to the claimed open bottom. In formulating the 103(a) rejection over Paternuosto, the final Office Action recognizes that “Paternuosto does not disclose that the restriction defined by the hour-glass shape is smaller than the open bottom.” See page 7 of the final Office Action. The Office Action, however, asserts that “it would have been obvious to one of ordinary skill of the art at the time of the invention that such a change in size/proportion could be made that would perform the same function as the invention of Paternuosto because this size/proportion change would still allow the fluids to flow through the

container ... without losing the biopsy samples that the device is designed to cut and retain for testing ... and because such changes in size/proportion are obvious." See page 7 of the final Office Action. Applicants respectfully disagree.

In discussing the prior art, Paternuosto discloses that conventional forceps for biopsy generally comprise two-half shells each of which has a front rim and base wall. In operation, these half-shells are used to cut and retain biopsy samples. Given the intrinsically limited nature of the space available, these conventional forceps hold at most 2-3 biopsy samples, which in turn, requires that the operator perform a plurality of introductions and withdrawals to obtain all the necessary samples. See pages 1 and 2 of Paternuosto. Paternuosto, therefore, expressly and specifically teaches the desirability for forceps that have at least one container element having a cavity for receiving a plurality of biopsy samples, and "take all the samples necessary for a given pathological condition, in succession, by performing only one introduction and withdrawal..." See paragraphs 3 and 4 of page 2 of Paternuosto.

If one skilled in the art were to alter the walls of container element 22 above and below hole 18 (i.e. the restricted neck) so that the size of the restriction is smaller than opening 24 in the base of container element 22, biopsy samples larger than the restriction would remain in half-shell 10b above the restricted neck and biopsy samples smaller than the restriction would pass through the restricted neck towards cavity 20. Since the samples that pass through the restricted neck are smaller than the size of opening 24 in the base of container element 22, these samples would pass through opening 24. No samples would collect in cavity 20. Similar to conventional forceps, therefore, half-shell 10b would at most hold a small number of biopsy samples in its

base wall 14, thereby requiring multiple introductions and withdrawals of the biopsy forceps to obtain all the necessary samples. A modification that renders the biopsy forceps unsatisfactory for its intended purpose, i.e., obtaining and storing a plurality of biopsy samples during one introduction and withdrawal, establishes that there is no suggestion or motivation to make the proposed modification. See MPEP § 2143.01 V.

Accordingly, claim 1 is allowable for at least this reason. Claims 2-12 and 78-82 depend from claim 1 and are allowable for at least the same reasons that claim 1 is allowable.

Rejection of claims 8, 21, 81-82, and 86-87 under 35 U.S.C. § 103(a)

On pages 10-11 of the final Office Action, dependent claims 8 and 21 were rejected under 35 U.S.C § 103(a) as being unpatentable over Paternuosto as applied to claims 1-7, 9-12, 14-20, 22-25, 27, 78-80, and 83-85 above, and further in view of U.S. Patent No. 5,662,671 to Barbut et al. ("Barbut"); and dependent claims 81-82 and 86-87 were rejected under 35 U.S.C § 103(a) as being unpatentable over Paternuosto as applied to claims 1-7, 9-12, 14-20, 22-25, 27, 78-80, and 83-85 above, and further in view of U.S. Patent No. 2,778,357 to Leibinger et al. ("Leibinger"). Applicants respectfully traverse these rejections. As set forth above, Paternuosto does not disclose or suggest every aspect of independent claim 1. Neither Barbut nor Leibinger remedy the deficiencies of Paternuosto. The rejections, for example, rely on Barbut and Leibinger for their alleged disclosure relating to features of the upper jaw recited in the dependent claims. Applicants therefore respectfully request withdrawal of the Section 103(a) rejection of claims 8 and 21 based on Paternuosto and Barbut, and the Section 103(a) rejection of claims 81-82 and 86-87 based on Paternuosto and Leibinger.

New claims 88-89

By this Amendment, Applicants have added new claims 88-89. The subject matter of new claims 88-89 is fully supported by the originally filed specification and drawings. No new matter is added. Accordingly, Applicants respectfully request examination and consideration of the newly submitted claims.

Conclusion

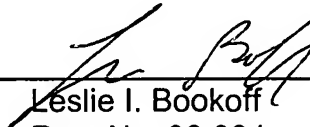
In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of prior art references cited in this application. Applicants therefore request entry of this amendment, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 
Leslie I. Bookoff
Reg. No. 38,084
(202) 408-4000